

REMARKS

Applicants acknowledge receipt of the Final Office Action mailed May 20, 2008.

In the Final Office Action, the Examiner objected to the drawings; objected to the specification; rejected claims 69-79, 81-83, and 86-90 under 35 U.S.C. § 112, second paragraph; rejected claims 69-73, 75-79, and 86-90 under 35 U.S.C. § 102(b) as being anticipated by *Wilkie et al.* (U.S. Patent No. 4,092,952); and rejected claims 74 and 81-83 under 35 U.S.C. § 103(a) as being unpatentable over *Wilkie* in view of *Copeland et al.* (U.S. Patent No. 5,595,707).

In this Amendment, Applicants propose to amend claims 69-74, 77-79, 82, 83, 86, 88, and 89, and cancel claims 75, 76, 81, 87, 90, without prejudice or disclaimer. Upon entry of this Amendment, claims 49-74, 77-79, 82-86, 88, 89, and 91-98 will remain pending, with claims 49-68, 84, 85, and 91-98 withdrawn from consideration. Of the claims under examination, claims 69 and 86 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 69-74, 77-79, 82, 83, 86, 88, and 89. No new matter has been introduced.

Applicants traverse the objections and rejections above and respectfully request reconsideration for at least the reasons that follow.

I. OBJECTION TO THE DRAWINGS

The drawings stand objected to under 37 C.F.R. § 1.83(a) as allegedly failing to show every feature of the invention specified in the claims. Specifically, the Examiner asserts, "the 'sample immerser element' and the 'slide immerser element' must be shown or the features canceled from the claims." (*Final Office Action*, p. 2,

paragraph 2). Applicants respectfully submit that the claimed “sample immerser element” and “slide immerser element” features have been canceled from the claims, without prejudice or disclaimer. Applicants therefore request that the objection to the drawings be withdrawn.

II. OBJECTION TO THE SPECIFICATION

The specification stands objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. In particular, the Examiner asserts that “[c]orrection of the following is required: ‘sample immerser element’ and ‘slide immerser element’ in claim[s] 69 and 86.” (*Final Office Action*, pp. 3-4, paragraph 3). Applicants respectfully submit that the objection to the specification has been rendered moot by the cancellation of the “sample immerser element” and “slide immerser element” features from claims 69 and 86. Applicants therefore request that the objection to the specification be withdrawn.

III. 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTION

Claims 69-79, 81-83, and 86-90 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter.

Specifically, the Examiner asserts that, with respect to claims 69 and 86, “it is not clear what elements in the figures or the specification correspond to the ‘sample immerser element’ and ‘slide immerser element’. . . Furthermore, it is not clear how the sample immerser element includes a slide immerser element. . . In addition, the specification does not clarify what is meant by the ‘sample immerser element’ or the ‘slide immerser element’. . . [Moreover,] [h]ow is the ‘sample immerse[r] element’

structurally connected to the 'slide immerser element'?" (*Final Office Action*, pp. 5-6, paragraph 5).

Applicants respectfully submit that the rejection of claims 69-79, 81-83, and 86-90 has been rendered moot by the cancellation of the "sample immerser element" and "slide immerser element" features from claims 69 and 86, and the cancellation of claims 75, 76, 81, 87, and 90. Applicants therefore request that the rejection of claims 69-79, 81-83, and 86-90 under 35 U.S.C. § 112, second paragraph, be withdrawn.

IV. 35 U.S.C. § 102(b) REJECTION

Applicants traverse the rejection of claims 69-73, 75-79, and 86-90 under 35 U.S.C. § 102(b) as being anticipated by *Wilkie*. Applicants respectfully submit that amended independent claims 69 and 86 distinguish over *Wilkie* at least for the reasons described below. Applicants further submit that the rejection of claims 75, 76, 87, and 90 has been rendered moot by the cancellation of those claims, without prejudice or disclaimer.

In order to properly establish that *Wilkie* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Wilkie appears to disclose an automatic slide stainer including a hollow enclosed framework with a base and a cover, the cover having a top annular platform. A dish containing a stain solution is mounted upon the platform. A dish of increased width is

mounted upon the platform adjacent to the first dish and adapted to contain another stain solution. A reservoir tank having an outlet is mounted upon the framework and adapted to contain a rinse solution. (*Wilkie*, Abstract).

Wilkie, however, does not disclose a slide elevator for lowering a slide rack with a substantially vertically disposed slide with at least one tissue sample, and submerging the slide in a fluid containment element, the slide remaining vertically disposed when submerged, as required by claims 69 and 86 (emphasis added).

Instead, as admitted by the Examiner, “[t]he *Wilkie* slide is vertically disposed at one point and the slide immerser element and slide positioner element 207, 215, 225 are able to rotate the slide between the substantially vertical position shown in Fig. 2 to a horizontal position in the fluid containment elements . . .” (*Final Office Action*, p. 7, paragraph 2). Furthermore, *Wilkie* discloses that “[t]he slide retainers 207-213 have a raised secured position such as shown in FIG. 2 . . . Each of the slide retainers has a horizontal position as shown in dash lines at S in FIG. 2. This corresponds to the slide emersion position . . .” (emphases added). (*Wilkie*, col. 6, ll. 63-68 and col. 7, ll. 17-18).

Accordingly, with respect to independent claims 69 and 86, *Wilkie* fails to teach Applicants’ claimed combination, including, *inter alia*:

a slide elevator for lowering [a] slide rack with a substantially vertically disposed slide with . . . at least one tissue sample, and submerging the slide in [a] fluid containment element, the slide remaining vertically disposed when submerged (emphasis added).

Since *Wilkie* fails to disclose each and every element of independent claims 69 and 86, *Wilkie* fails to anticipate claims 69 and 86, and claims 70-73, 77-79, 88, and 89,

that correspondingly depend from claims 69 and 86. Therefore, Applicants respectfully request that this rejection be withdrawn.

V. 35 U.S.C. § 103(a) REJECTION

Applicants respectfully traverse the rejection of claims 74 and 81-83 under 35 U.S.C. § 103(a) as being unpatentable over *Wilkie* in view of *Copeland*. The deficiencies of *Wilkie* are discussed above. Applicants further submit that the rejection of claim 81 has been rendered moot by the cancellation of that claim, without prejudice or disclaimer.

The Examiner relies on *Copeland* for allegedly disclosing “a rotating slide rack 24 configured to accommodate a plurality of slides 26 and a drawer assembly 22 ‘adapted to’ retract from the system, wherein the drawer assembly comprises the slide rack on the top surface . . .” (*Final Office Action*, p. 9, paragraph 11). Such teaching, even if present in *Copeland*, however, fails to teach or suggest, *inter alia*,

a slide elevator for lowering [a] slide rack with a substantially vertically disposed slide with . . . at least one tissue sample, and submerging the slide in [a] fluid containment element, the slide remaining vertically disposed when submerged,

as required by claim 69 (emphasis added).

Therefore, *Wilkie* and *Copeland* fail to teach or suggest all of the limitations of independent claim 69, and claims 74, 82, and 83 are therefore patentable over *Wilkie* and *Copeland* at least due to their dependence from independent claim 69. Applicants therefore request that the rejection of claims 74 and 81-83 under 35 U.S.C. § 103(a) be withdrawn.

VI. CONCLUSION

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 69-74, 77-79, 82, 83, 86, 88, and 89 in condition for allowance. Applicants submit that the proposed amendments of claims 69-74, 77-79, 82, 83, 86, 88, and 89 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 18, 2008

By:

A handwritten signature in black ink, appearing to read 'Anthony C. Tridico', is written over a horizontal line.

Anthony C. Tridico
Reg. No. 45,958